

REMARKS

Applicant wishes to thank the Examiner for discussing the pending issues by phone on December 3, 2002. In accordance with the discussion, Applicant requests that the Examiner reconsider the application as amended herein.

A. Claim Rejections under 35 U.S.C. § 112

The former Examiner has rejected claims 4, 5 and 31-34 under 35 U.S.C. § 112 arguing that there is insufficient disclosure of "coded control instructions" or "programmed control instructions." The Federal Circuit has recently reiterated the requisites for satisfying the written description requirement of 35 U.S.C. § 112. In *Moba B.V. v. Diamond Automation Inc.*, 325 F.3d 1306, the Federal Circuit stated:

The test for compliance with § 112 has always required sufficient information in the original disclosure to show that the inventor possessed the invention at the time of the original filing. See [*Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561] ("Adequate description of the invention guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation"). The possession test requires assessment from the viewpoint of one of skill in the art. *Id.* at 1563-64 ("the applicant must ... convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention") (emphasis in original); *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000) ("The written description requirement does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed'") (citation omitted).

Moba B.V., 325 F.3d at 1320-1321 (emphasis added).

Utilizing this test, it is apparent that the patent as originally filed does disclose the claimed invention. Notably, the Applicant's specification describes that the control unit 18 of the invention is "programmable." Specification, p. 5, line 24. In addition, the control unit is described as including a "microprocessor." Specification, p. 6, line 11. Given these statements, one skilled in the art would understand that an embodiment of the invention may utilize programming instructions or include an instruction set or coded control instructions to implement the functionality of the invention. Accordingly, Applicant submits that the rejected phrases are sufficiently "disclosed" for purposes of satisfying the written description requirement of 35 U.S.C. § 112. For these reasons, Applicant requests that the rejection be withdrawn.

B. Means Claims language under 35 U.S.C. § 112

It is the former Examiner's position that the functions defined by the claims do not sufficiently invoke the means-plus-function provision of 35 U.S.C. § 112 because of the absence

of the word "for". While Applicant disagrees with this conclusion, for purposes of expediting the application process in a manner consistent with the PTO's Patent Business Goals (PBG), 65 Fed. Reg. 54603 (Sept. 8, 2000), Applicant has now amended the claims to include the term "for".

C.. Claim Rejections under 35 U.S.C. § 102 and 103

The former Examiner has rejected the claims of the application under 35 U.S.C. § 102 and 103 as being anticipated or obvious in view of the patent to Sullivan et al, U.S. Patent No. 5,246,995. Applicant disagree with this rejection since the Sullivan et al. patent does not disclose a display adjusting circuit means that will restrict the respiratory related signal within a predetermined display range. However, in light of the former Examiner's comments, Applicant requests that the rejection be withdrawn based on the amended claims submitted herewith. It is the former Examiner's position that the Sullivan et al. device adjustment of treatment pressure inherently results in a restriction within a predetermined display range. To clarify that such adjustment is not intended by the claims, the independent claims have been amended to define that the display restriction or adjustment does not change the pressure of the air delivered from the respiratory apparatus to the patient. Accordingly, Applicant submits that the claims define novel and non-obvious subject matter not disclosed in the prior art.

Therefore, Applicant submits that the current application is in condition for allowance. Early and favorable allowance is therefore requested.

Respectfully submitted,
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